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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/046,968	01/17/2002	Reinhold Holtkamp SR.	030502/0147	5426

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EXAMINER

HAAS, WENDY C

ART UNIT PAPER NUMBER

1661

DATE MAILED: 06/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/046,968

Applicant(s)

HOLTKAMP, REINHOLD

Examiner

Wendy C Haas

Art Unit

1661

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 17 January 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 January 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 8.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: Decision on petition

## DETAILED ACTION

### *Double Patenting*

#### Statement of authority:

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Section 1601 of the MPEP sets forth that "An asexually reproduced plant may also be protected under 35 U.S.C. 101, as the Plant Patent Act (35 U.S.C. 161) is not an exclusive for of protection which conflicts with the granting of utility patents to plants. *Ex parte Hibberd*, 227 USPQ 443 (Bd. Pat. App. & Int. 1985). Inventions claimed under 35 U.S.C. 101 may include the same asexually reproduced plant which is claimed under 35 U.S.C. 161, as well as plant materials and processes involving plant materials. The filing of a terminal disclaimer may be used in appropriate situations to overcome an obvious-type double patenting rejection based on claims to the asexually reproduced plant and/or fruit and propagating material thereof in an application under 35 U.S.C. 101 and the claim to the same asexually reproduced plant in an application under 35 U.S.C. 161."

Claims 1-3 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Plant Patent No.13789. Although the conflicting claims are not identical, they are not patentably distinct from each other because the plant patent claims a multiflorescent African Violet plant.

Claims 1-3 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Plant Patent No.13842. Although the conflicting claims are not identical, they are not patentably distinct from each other because the plant patent claims a multiflorescent African Violet plant.

Claims 1-3 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Plant Patent No.13786. Although the conflicting claims are not identical, they are not patentably distinct from each other because the plant patent claims a multiflorescent African Violet plant.

Claims 1-3 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Plant Patent No.13818. Although the conflicting claims are not identical, they are not patentably distinct from each other because the plant patent claims a multiflorescent African Violet plant.

### ***Specification***

The disclosure is objected to because of the following informalities:

Pages 4 and 8, applicant should provide the ATCC accession number of the deposited seeds.

Page 6, applicant should correct the references to the multiflorescent African Violet cultivars by providing the patent number for each, as appropriate.

### **Claim Rejections - 35 USC § 112, 1st paragraph**

#### **Enablement**

The following is a quotation of the first paragraph of 35 U.S.C. 112:

*The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.*

Claims 1-8 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Specifically, applicant is required to make a deposit of biological material, as it is clear from the specification and claims that the claimed invention cannot be practiced without access to plant material that exhibits the mutant multiflorescent trait. The specification does not adequately teach how to make multiflorescent African Violet plants, as the plant and its parents are cosmic mutants, which makes the method not reproducible (mutation being a random process).

The invention employs novel plants and seeds. Since the plants and seeds are essential to the claimed invention they must be obtainable by a repeatable method set forth in the specification or otherwise be readily available to the public. If they are not so obtainable or available, the requirements of 35 U.S.C. § 112, regarding "how to make" the invention may be satisfied by deposit.

For a plant, a deposit of 2500 seeds is generally considered adequate to ensure availability of each claimed embodiment. In the instant case, the deposit of seeds carrying a dominant multiflorescent trait is necessary to satisfy the "how to make" the invention requirement. The specification does not disclose a repeatable process to obtain the plants and seeds, for the reasons discussed above. If the deposit is made under the terms of the Budapest Treaty, then an affidavit or declaration by applicants, or a statement by an attorney of record over his or her signature and registration number, stating that the seeds have been deposited under the Budapest Treaty and that it will be irrevocably and without restriction released to the public upon the issuance of a patent, would satisfy the deposit requirement made herein.

If the deposit is not made under the Budapest Treaty, then in order to certify that the deposit meets the criteria set forth in 37 CFR 1.801-1.809, applicants may provide assurance of compliance by an affidavit or declaration, or by a statement by an attorney of record over his or her signature and registration number, showing that

- (a) during the pendency of this application, access to the invention will be afforded to the Commissioner upon request;
- (b) all restrictions upon availability to the public will be irrevocably removed upon granting of the patent;
- (c) the deposit will be maintained in a public depository for a period of 30 years or 5 years after the last request or for the effective life of the patent, whichever is longer; and,
- (d) a test of the viability of the biological material at the time of deposit (see 37 CFR 1.807); and,
- (e) the deposit will be replaced if it should ever become not viable.

This rejection could be obviated by making the required deposit, providing the required deposit information in the specification and claims, and limiting the claims to the deposited material and progeny thereof (and methods employing same).

### **Written Description**

Claims 1-3 and 7 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. These claims are drawn to any viable African violet seeds and/or plants with more than one inflorescence per leaf axil. In analyzing whether the written

description requirement is met for genus claims, it is first determined whether a representative number of species have been described by their complete structure. (It is not realistic to expect that the "complete structure" of a plant, or even a cell, could be described. Therefore the inquiry required by this portion of the written description guidelines is interpreted to be whether the phenotype of the claimed plant has been described.)

In this case, the few disclosed embodiments are not representative of the enormous number of products claimed. The claims encompass all African violet plants with a particular inflorescence architecture, regardless of its origin, all African violet plants produced by cross breeding with plants exhibiting a particular inflorescence architecture, and all seeds or plants grown from some hypothetical deposited seeds. Plants have many phenotypic traits, which vary independently, so millions of possible phenotypes are possible and claimed. The specification discloses only a few specific multiflorescent African Violet plants but not the heterogeneous population claimed.

Next, it is determined whether a representative number of species have been sufficiently described by other relevant identifying characteristics. It is not possible to adequately describe the claimed products because the cross of a hybrid plant gives rise to a heterozygous population. One skilled in the art would not be able to predict all of the resulting phenotypes. The limited disclosure in the specification is not deemed sufficient to reasonably convey to one skilled in the art that Applicants were in possession of the huge genera recited in the claims at the time the application was filed. Thus, it is concluded that the written description requirement is not satisfied for the claimed genera.

This rejection could be overcome by limiting the claims to the deposited seeds, plants grown therefrom and their asexually propagated progeny.

#### **Claim Rejections - 35 USC § 112 2nd paragraph**

The following is a quotation of the second paragraph of 35 U.S.C. 112:

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*The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.*

Claim 4 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, claim 4 does not provide an ATCC accession number.

### **Conclusion**

No claims are allowed. All claims are free of the prior art (besides the cited patents) because the prior art does not teach or suggest the multiflorescence trait in African violets.

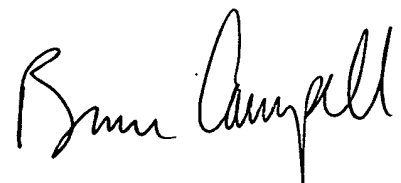
### **Future Correspondence**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wendy C. Haas whose telephone number is (703) 308-8898. The Examiner can normally be reached Monday through Friday from 9:30 a.m. to 5:00 p.m.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Bruce Campell, can be reached on (703) 308-4205. The official fax numbers for the Technology Center are Before Final: 703-872-9306 After Final: 703-872-9307 Customer Service: 703-872-9305.

Any inquiry of a general nature or relating to the status of this application should be directed to the Matrix Customer Service Center whose telephone number is (703) 308-0196.

W. C. Haas



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